

REMARKS/ARGUMENTS

Claims 1-12 were pending. New claims 13-20 are entered. No new matter has been introduced thereby.

Claims 1-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button".

Claims 11-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (McCormick-"Here is a zmail ban-spam button") in view of "FTC searches for spam solution" Courtney Macavinta (Staff Writer, CNET News.com June 12, 1997) ("Courtney").

Frankly speaking, Applicant is perplexed regarding the Examiner's "new" grounds of rejections of claims 1-10, as the "new" grounds are the same as the old grounds. The Examiner stated that:

Applicant's amendment filed 12/04/2003 with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection." Page. 2, ¶2.

As noted above and further emphasized, the "new" grounds of rejection for claims 1-10, however, are identical to the previous grounds of rejection in the prior Office Action. In the present Office Action, the grounds of rejection were stated on page 2, ¶7:

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).

As clearly shown, the statement above is a carbon copy of the express language used in the rejection in the action mailed 05/05/2003. For the Examiner's convenience, Applicant has provided his statement on page 3, ¶5 below:

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).

Accordingly, the Examiner has not provided any new grounds for rejection of claims 1-10. Applicant urges the Examiner to allow the subject claims, which are clearly patentable over the cited art, or allow the subject application to proceed to Appeal.

Cited Prior Art

McCormick was previously discussed in the Appeal Brief mailed 12/4/03 as a "reactive" system that simply filters-out unwanted e-mail messages, but does nothing to prevent them.

Zmail was also previously discussed in the Appeal Brief as a "passive" system that provides e-mail filters but does nothing to prevent further e-mail messages.

Courtney appears to be an article describing possible FTC regulation of spam. Specifically, Courtney describes that the FTC currently has the power to "Crack down" on unfair and deceptive e-mail practices, ¶3, by obtaining court orders to shut down or to fine violators, ¶3. Courtney also describes the formation of a private organization of marketers called the "Internet marketing Council." ¶7. Additionally, Courtney describes that members of the IMC must give customers a way to "opt-out" from receiving messages. ¶8. Courtney also describes another industry group called the "Direct marketing Association" that describes that members must offer an "opt-out" choice. ¶9.

Courtney then describes one bill that requires an advertiser to "include the sender's accurate contact information including physical address and phone." ¶10. Another bill describes giving the FTC power to "bust spammers who don't give an opt-out preference." ¶15. False return addresses are "punishable by a fine of up to \$5,000." ¶15.

As can be seen, Courtney merely describes the FTC may be given powers to "bust spammers who don't give an opt-out preference," however Courtney makes no reference about a computer system, or how a computer system could be used to implement such functionality. Further Courtney makes no mention regarding enforcement of users' actual "opt-out" requests.

As will be further emphasized, the FTC is not the claimed invention but is an independent Federal Government agency. Specific language from the FTC web site has been provided below.

"The FTC is an independent agency that reports to Congress on its actions. The Commission is headed by five Commissioners, nominated by the President and confirmed by the Senate, each serving a seven-year term. The President chooses one Commissioner to act as Chairman. No more than three Commissioners can be of the same political party." See, ftc.gov.

Using this information as background, Applicant respectfully traverses the Examiner's rejection.

Cited Prior Art Distinguished

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness in light of McCormick and Zmail for substantially the same reasons discussed in the Appeal Brief mailed 12/4/03.

Even if it is asserted claims 1-12 are obvious in view of the combination of McCormick and Zmail and Courtney, such an assertion is also traversed. As discussed above, Courtney merely describes a proposed power of the FTC to make spammers give an opt-out preference. Courtney fails to suggest any mechanism for performing this action, for example, the FTC could simply receive telephone complaints and file a lawsuit. Further the FTC is merely a collection of government workers and no mention is made about a "policing server" as recited

in claims 1-12. Additionally Courtney merely discusses the FTC making spammers give an opt-out preference, but does not make any reference to receiving indications of unsolicited e-mail messages as recited in claim 1.

Additionally, the Examiner has not given any reason as to why one of skill in the art would have been motivated to combine the references. As discussed above, McCormick and Zmail describe a reactive system that merely sets up e-mail filters and then uses them. In contrast, Courtney merely describes a bill that may allow the FTC to force spammers to provide "opt-out preferences." The former references do not contemplate nor suggest having any third-parties involved in filtering-out e-mails. Further, the Courtney reference does not even suggest combining the described capability with any existing system. Accordingly, the references do not give any motivation or suggestion be combined, and the Examiner has not demonstrated any other motivation to combine these references.

Even if the references could be combined as asserted by the Examiner, the combination does not disclose the elements in claims 1-12. As discussed, McCormick and Zmail describe an e-mail filtering system, and for sake of argument, assume that Courtney describes an FTC system that "busts spammers who don't give an opt-out preference." It is asserted that the combination does not disclose the missing elements. For example a combination would be an FTC system that has an e-mail filtering capability, and the ability to "bust spammers who don't give an opt-out preference." These two separate functions are distinct and still do not disclose all the elements recited in claims 1-12.

For substantially the same reasons, new claims 13-20 are also asserted to be allowable. Additionally, the new claims are asserted to be allowable for the specific limitations they recite.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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